

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-3, 5-19, 27-29 and 31-41 are pending. Claims 4, 20-26, 30, and 42-46 have been previously cancelled. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

B. Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 5, 6, 18, 19, 27, 28, 31, 32, 40 and 41 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 7,305,351 to Bechhofer *et al.* (“Bechhofer”). Office Action, page 2. Specifically, the Office Action asserts that Bechhofer discloses all elements of these claims. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). “The identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP 2131 (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The Federal Circuit recently reiterated the standard for anticipation under 35 U.S.C. § 102, stating:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net Moneyin v. Verisign, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008). Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking,

choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting *In re Arkley*, 172 USPQ 524 (CCPA 1972)).

Bechhofer fails to disclose all claim elements of the claims of the present application. Indeed, for the most part, Bechhofer’s disclosure has nothing to do with the claims. The claims of the present application are all directed to providing ***business continuity*** in an enterprise. For example, the specification discloses business continuity as follows:

The present invention is a system and method for developing and implementing plans and procedures for providing continuity to business operations in cases of business interruption. Such business interruption can occur due to a variety of reasons including physical facility emergency. The continuity in business operations relates at least to real estate, personnel, and critical business resources such as computers, databases and applications.

Appl’n, ¶ 0011.

Bechhofer, however, discloses a system and method for ***managing risk*** and ***opportunity***, and describes ***risk*** and ***opportunity*** as follows:

FIG. 1 shows an exemplary revenue forecast chart 1 for a corporation. Expected revenue 2 is charted against time 3 resulting in exemplary revenue curve 4. However, there are factors that can move the revenue forecast in either the positive or the negative direction. Positive changes may result in the revenue forecast being revised up to exemplary revenue curve 5, while negative changes may result in the revenue forecast being revised down to exemplary revenue curve 6. ***The negative effects, which may be termed “risks,” are dangers that events, acts or omissions may obstruct a corporation in the achievement of its objectives or the successful implementation of its strategies. Risk includes all these events, internal or external to the corporation, that have the potential to threaten the success of the company, and is not limited to unexpected negative developments.*** For example in FIG. 1, at time 11 the forecast is for revenue 12.

However, because of potential risks, there may only be actual revenue 13 at time 11. *The positive effects in the revenue forecast may be termed “opportunities.” An opportunity is the potential that an option which may help the corporation to achieve its objectives or its strategic goals may be available in the future.* For example in FIG. 1, at time 10 the forecast is for revenue 14. However, because of potential opportunities, there may be actual revenue 15 at time 10. Those skilled in the art will understand that the quantification of risks and opportunities is not limited to revenue forecasts, but can be applied to other monetary forecasts, for example, earnings, sales, etc., and non-monetary forecasts, for example, market share, number of employees, new technologies, new applications, new product/process developments, etc.

Bechhofer, Col. 2, l. 53-col. 3, l. 16 (emphasis added). Clearly, “risk” and “opportunity” are not the same as “business continuity.”

Despite this clear difference, the Office Action has cited passages in Bechhofer that have nothing to do with the claims. For example, in support of its allegation that Bechhofer discloses “collecting department information describing at least one department within the enterprise,”¹ the Office Action cites the following passages:

Business units 300 are responsible for the ongoing identification and evaluation of risks/opportunities within the business and selecting and implementing risk/opportunity management measures on a day-to-day basis.

Id., Col. 13, ll. 53-56.

Business units 300 may also manage certain risks/opportunities through the use of facilities and services provided by staff departments 310.

Id., Col. 14, ll. 7-9. Neither of these passages has anything to do with collecting

¹ Note that independent claim 27 recites similar elements to those in independent claim 1.

information describing at least one department with the enterprise. Rather, these passages simply disclose that business units identify and evaluate risk/opportunity.

Similarly, there is no disclosure of “assessing a criticality of the at least one department.” In alleged support, the Office Action again cites column 13, lines 53-56 (reproduced above). The “ongoing identification and evaluation of risks/opportunities within the business and selecting and implementing risk/opportunity management measures on a day-to-day basis” is not “assessing the criticality of a business unit.” Indeed, nothing in this passage suggests anything having to do with the criticality of the business unit, but only the identification of risks/opportunities.

Moreover, there is no disclosure of “developing a recovery plan for recovery from a degradation of a functionality of the at least one department, wherein the recovery plan aims to ensure the business continuity of the at least one department.” The Office Action cites the following in alleged support of its rejection:

The second pillar includes staff departments 310 and corporate risk/opportunity management department 320 that support business units 300 and have responsibility for risk/opportunity policy setting, risk/opportunity oversight and for developing tools and standards for the implementation of risk/opportunity management.

Bechhofer, Col. 13, ll. 38-43. As with other elements, nothing in this passage addresses any sort of recovery plan, but only the responsibility for risk/opportunity policy setting. Further, because there is no disclosure of a “recovery plan,” there is no disclosure of other claim elements, including “assessing the recovery plan”; “testing the recovery plan and recording the results of the testing”; and “providing status data from the electronic database, wherein the status data comprises at least one of a status of: the collection of the department data; the assessment of the criticality; the development of the recovery plan; and the testing of the recovery plan.”

Finally, the Office Action repeatedly cites column 11, lines 30-32, which refers to a “computer based tool designed to compile and analyze risk and opportunity related input” in alleged support of its allegation that Bechhofer discloses storing certain information in an electronic database. This passage, however, does not refer to storing anything in a database, let alone the claimed information (*e.g.*, the department information, the assessment of the criticality of the at least one department, the recovery plan, the assessment of the recovery plan, the recorded results of the testing). Thus, this element is also not disclosed.

For at least these reasons, Applicants respectfully request that the rejection of independent claims 1 and 27, and all claims dependent thereon, be withdrawn.

C. Claim Rejections Under 35 U.S.C. § 103(a)

The Office Action has rejected the following dependent claims under 35 U.S.C. § 103:

- Claims 3, 17, 29 and 39, as allegedly rendered obvious by Bechhofer in view of U.S. Patent Publication No. 2004/0103431 to Davenport;
- Claims 7-14 and 33-36, as allegedly rendered obvious by Bechhofer and U.S. Patent No. 5,185,697 to Jacobs; and
- Claims 15, 16, 37 and 38, as allegedly rendered obvious by Bechhofer, Jacobs and further in view of U.S. Patent Application Publication No. 2005/00114653 to Suddia.

All of these claims are dependent on either independent claim 1 or independent claim 27. As discussed above, Bechhofer fails to disclose all elements of these claims, and the additional references (*i.e.*, Davenport, Jacobs, and Suddia) do not cure the many shortcomings of Bechhofer. Therefore, because independent claims 1 and 27 are allowable, so are the dependent claims. *See* MPEP 2143.03 (“If an independent claim is nonobvious under 35 U.S.C 103, then any claim depending therefrom is nonobvious.”) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)).

Therefore, Applicant respectfully requests that the rejections of these claims be withdrawn.

IV. CONCLUSION


In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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